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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,225	08/03/2006	Heinz Mueller	C 2858 PCT/US	3536
29737 7590 07/23/2009 SMITH MOORE LEATHERWOOD LLP P.O. BOX 21927 GREENSBORO, NC 27420			EXAMINER ADMASU, ATNAF S	
			ART UNIT 1796	PAPER NUMBER
			NOTIFICATION DATE 07/23/2009	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

phil.mccann@smithmoorelaw.com  
lorna.selvaggio@smithmoorelaw.com  
mary.garner@smithmoorelaw.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/566,225	<b>Applicant(s)</b> MUELLER ET AL.	
	<b>Examiner</b> ATNAF ADMASU	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 12-30 are pending as amended on 17 March 2009.
2. The text of those sections of Title 35, US Code not included in this action can be found in a prior Office Action.

### ***Response to Amendment and Arguments***

3. Applicants amendment specifically amending claim 21 to correct the parenthetical issue has been fully considered and overcomes the following:

The rejection of claims 21 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn.

4. Applicant's amendment specifically amending claim 22 to add a left bracket to section (g) has been entered and fully considered.

5. Applicants argument, filed 17 March 2009, specifically that US Patent 5,869,434 (Mueller '434 hereinafter) does not teach oil based invert drilling fluids but it is teaching away from using oils, including free fatty acids, in connection with drilling fluids, has been fully considered and is persuasive.

The rejection of claims 20-22 under 35 USC 103(a) as being unpatentable over US Patent 4,582,138 (Balzer hereinafter) in view of Mueller '434, has been withdrawn.

6. Applicant's further arguments have been fully considered but they are not persuasive.

Applicant argues that the instant claims are directed to drilling fluids to facilitate the generation of sinking wells in solid materials while the disclosure of Balzar pertains to a quite different technology directed to oil recovery process by tenside and/or emulsion flooding using carboxymethylated oxethylates. It is, however, noted that Balzar and the instant claims are both analogous art because they are concerned with the same field of endeavor, namely fluid compositions for oil recovery. The fact that Applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bb. Pat. App. & Inter. 1985).

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 21 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

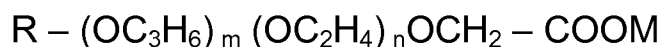
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had possession of the claimed invention. The recited claim, wherein the new end point in a well servicing composition flowable and pumpable at 50 to 20°C is not supported by the teaching of Applicant's original disclosure or claims, and that this is a new matter rejection.

***Claim Rejections - 35 USC § 102***

9. Claims 12 – 19 and 23 -30 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 4,582,138 (Balzer hereinafter).

Regarding claims 12, 17, 18, 23, 24, 27 and 29, Balzer teaches emulsifiers and tensides, carboxymethylated oxethylates for oil recovery of the formula:



wherein R is a linear or branched aliphatic residue of 6-20 carbon atoms or an alkylaromatic residue of 3-18 carbon atoms in the alkyl group, or a dialkylaromatic residue of 1-18 carbon atoms per alkyl chain, the total number of carbon atoms in both alkyl chains being 5-30, or a trialkylaromatic residue of 1-18 carbon atoms per alkyl chain wherein the total number of carbon atoms in the three alkyl chains is 6-40, m is 0-20, n is 1-20, M is an alkali or alkaline earth metal ion or ammonium column 4, lines 33 – 45).

Regarding claims 13 - 15, Balzer teaches the emulsion comprising an oil phase, an aqueous phase, and a carboxymethylated oxethylate as the emulsifier (column 4,

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lines 8 – 9). The additives are water soluble co-surfactants such as mono- and polyhydric alcohols (column 4, lines 60 – 62).

Regarding claim 16, Balzer teaches the crude oil or the oil phase consists of parafinic hydrocarbons (column 14, lines 43 – 45).

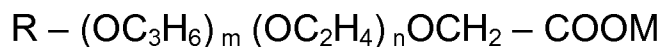
Regarding claims 19, 25, 26 and 28, Balzer teaches that the emulsifier concentration is 0.2 – 15% by weight based on the aqueous phase (column 8, lines 46 - 48).

Regarding claim 30, Balzer teaches the volume ratio of organic phase to aqueous phase in the emulsion is 3:1 to 1:10 (column 4, lines 55 – 56).

### ***Claim Rejections - 35 USC § 103***

10. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Balzar in view of US Patent 5,232,910 (Mueller '910 hereinafter) (Cited by Applicant).

Balzar teaches emulsifiers and tensides, carboxymethylated oxethylates for oil recovery of the formula:



as detailed above.

Regarding claim 20, Balzer does not expressly disclose the composition additionally comprises free fatty acids.

Regarding claim 20, Mueller '910 teaches esters of monofunctional carboxylic acids with monofunctional alcohols derived from triglycerides are suitable for the production of drilling fluids. Mueller '910 further discloses the ester oils of monofunctional components undergo partial hydrolysis, resulting in the formation of free fatty acids. These free fatty acids react in turn with alkaline constituents always present in invert drilling fluids to form the corresponding salts (column 2, lines 42-57).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the free fatty acid of Mueller '910 in the oil recovery composition of Balzar. The rationale to do so would have been the motivation provided by the teaching of Mueller '910 that to do so would have the additional advantage of increased environmental compatibility (column 2, lines 38-39).

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ATNAF ADMASU whose telephone number is (571)270-5465. The examiner can normally be reached on M-F 8:00-5:30, Flexible Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ASA/

/Timothy J. Kugel/  
Primary Examiner, Art Unit 1796